

Amendment Responsive to O.A. dated 8/17/99
Serial No. 08/987,995 filed 12/10/97
PORTABLE ELECTRONIC APPARATUS

A1

Amend

SCB 3/1

3/1

10/11

17. (New) A radio telephone according to claim 12, wherein the sensor is adapted to sense a charging voltage for charging the rechargeable power supply of the radio telephone.

18. (New) A radio telephone according to claim 12, wherein operation of the radio telephone is restorable responsive to a security code input to the radio telephone.

19. (New) A method for inhibiting unauthorized use of a radio telephone comprising the steps of sensing whether the radio telephone is coupled to a charging device and automatically inhibiting operation of the radio telephone responsive to sensing absence of the charging device.

REMARKS

The present amendment is responsive to the Office Action dated August 17, 1999. Claims 12-19 are presently in the application, claims 1-11 being canceled by the instant amendment in order to more accurately define the invention which applicant seeks to protect. All of the canceled claims stood rejected by the Office Action.

A Petition for Extension of Time Under 37 CFR 1.136 providing the appropriate extension fee accompanies this amendment in view of its being filed subsequent to three months following the mailing date of the Office Action.

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As related in the disclosure of this application, the present invention relates to portable electronic apparatus, specifically, a radio telephone provided with a sensor for sensing whether or not the radio telephone is coupled in intimate proximity to a rest. The rest may be a desk top, a car instrument panel top or a special stand for the telephone. The portable radio telephone also has an inhibitor which inhibits operation of, or locks the telephone against operation, when the sensor senses that the telephone is absent from the rest.

Claims 1-3, and 10-11 have been rejected under 35 U.S.C. 102(e) "... as being anticipated by French (US Patent Number 5,760,690)" with the further comment:

"Regarding claims 1, 11, French teaches a portable electronic apparatus comprising:

 a sensor for sensing the portable electronic apparatus coupled in intimate proximity to a rest, and

 inhibiting means responsive to the sensor sensing absence of said intimate proximity to the rest for automatically inhibiting operation of the portable electronic apparatus (Column 2 lines 62-67, Column 3 lines 9-11).

Regarding claim 2, French teaches a Portable electronic apparatus wherein the sensor and locking means are operative for a power on mode of the portable electronic apparatus (Column 5 lines 37-43).

Regarding claim 3, French teaches a portable electronic apparatus wherein the inhibiting means is adapted to inhibit access to information stored in the portable electronic apparatus (Column 2 lines 17-21).

Regarding claim 10, French teaches a Portable electronic apparatus wherein operation of the portable electronic apparatus restorable

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responsive to a security code input to the portable electronic apparatus (Column 2 lines 10-14, Column 5 lines 15-18)."

Of course, the rejection is now moot in view of the introduction of new claims which more particularly define the applicant's invention.

The patent to French discloses a portable computer with an integrated alarm system which provides for the sounding of an alarm or for disabling the computer upon unauthorized movement of the computer from an initial stationary position. With such an arrangement, theft of the portable computer can be prevented without the need to fasten it to a surface with a mechanical device and such protection is provided by integration of the alarm system into the computer system of the very computer which is to be protected.

The Examiner has rejected the claims of the instant application on the basis of the French citation which, as noted, discloses a laptop computer that is equipped with motion detection sensors which detect movement of the laptop from its stationary position. Any detected movement of the laptop causes the triggering of French's alarm system which includes disabling the computer system of the laptop.

Respectfully, the instant invention is different. Commonly, when one wishes to re-charge a mobile phone battery, the phone (with contained battery) is placed on a deskstand charger. It is customary to leave the phone switched on while it charges up in case someone wishes to call the owner on it. Further, while the phone is

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charging, the owner may well depart the area of the desk, leaving the phone unguarded. In such a situation, it would be easy for an opportunist thief as he walks by simply to remove the mobile phone from the deskstand charger and make off with the phone. What the present invention is concerned about is making sure that if that should happen, then the opportunist thief having stolen the phone cannot actually use the owner's mobile phone, e.g., for making calls or accessing data. This is because once the phone is removed from the charger, the password or pin code must be keyed into the phone before it can be operated. In other words the phone automatically disables itself when removed from the charger. This is accomplished in the present invention through the provision of a 'sensor' which senses the presence or absence of the charger, and an 'inhibiting means' that disables the phone when the sensor detects the absence of the charger. To then re-enable the phone, the user must input his pin code into it. Thus, the present invention provides a very useful security feature for a mobile phone left powered on while charging.

Thus, in contrast to the French invention, the present invention does not concern itself with sensing the movement of the phone, but instead is concerned with coupling and separation between the phone and the charger. It is conceivable that the mobile phone might be moved around on the desk while remaining on the deskstand charger; the functionality of the phone in this case would not be disabled. Using the motion detecting sensors of French, the phone would be disabled. Furthermore, in the present invention, the security feature works automatically, whereas in French the security function needs to be activated every

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time the user wishes it to be operative. That is, unlike in French, the security feature of the present invention can be left on continuously, which is to say, the user does not need to activate the security feature every time he wants to place the phone on the charger. In French, it would appear that whenever the laptop is about to be left unattended, the user would need to switch on the alarm system, and then switch it off when he wishes to be mobile with the laptop. Otherwise, movement of the laptop by the user would trigger the alarm system.

In short, then, the French reference does not disclose detecting absence or presence, with which the present invention is concerned, but movement with which the present invention is not concerned.

In this instance, it is considered appropriate to make note of the clear and unmistakable policy of the Court of Appeals for the Federal Circuit regarding anticipation. In the definitive case of Structural Rubber Products Co. v. Park Rubber Co. et al, 223 USPQ 1264 (CAFC 1984), that Court stated:

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); Radio Steel & Mfg. Co. v. MTD Products, Inc., 731 F.2d 840, 845, 221 USPQ 657, 661 (Fed. Cir. 1984); Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); Kalman v. Kimberly - Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983); SSIH Equipment, S.A. v. U.S. Int'l. Trade Comm'n., 718 F.2d 365, 377, 218 USPQ 678, 688 (Fed. Cir. 1983)."

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As to each of Claims 12-19 presently in the application, there is simply no prior disclosure of each and every element of the claimed invention.

Accordingly, it is submitted, claims 12-19 are patentable over French and a finding to this effect is respectfully solicited.

Claims 4-9 have been rejected under 35 U.S.C. 103(a) "... as being unpatentable over French (US Patent Number 5,760,690) in view of the admitted prior art" with the further commentary:

"Regarding claim 4, French fails to teach that the Portable electronic apparatus wherein the portable electronic apparatus comprises a radio telephone. However the admitted prior art disclose the problem of unauthorized user of a radio telephone. Therefore, it would have been obvious to ordinary skill in the art at the time the invention is made to provide the above teaching the admitted prior art to French, in order to provide protection for the Cellular phone users.

Regarding claims 5-6, French as modifies by the admitted prior art discloses the inhibiting means. Therefore the user cannot make outgoing call, and inhibits access to subscriber identity information stored in the memory.

Regarding claim 7, French fails to teach a Portable electronic apparatus wherein the rest is a base unit. However the admitted prior art disclose a radio telephone and desk stand charger unit (Page 1). Therefore, it would have been obvious to ordinary skill in the art at the time the invention is made to provide the above teaching of the admitted prior art to French, so that the user does not have to replace a new battery.

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Regarding claims 8-9, French fails to teach a Portable electronic apparatus wherein the sensor is adapted to sense the portable electronic apparatus coupled in intimate proximity to a base unit, and the base unit comprising charging unit to sense a charging voltage for charging the rechargeable power supply. However the admitted prior art teaches a base unit comprising a charger (See page 1) which contains the rechargeable battery. Therefore, it would have been obvious to ordinary skill in the art at the time the invention is made to provide the above teaching of the admitted prior art to French, so that the user does not have to replace a new a battery."

Again, as mentioned earlier, the French reference does not disclose detecting absence or presence, with which the present invention is concerned, and although many of the features disclosed and claimed by the applicant are found in the cited art in somewhat analogous structures, that fact alone does not serve to diminish the allowability of the claims. The Court in Connell v. Sears, Roebuck & Co., 220 USPQ 193 (CAFC 1983), treated this very situation when it said:

"It is not 'features' but the subject matter of the invention 'as a whole' that must be considered, 35 U.S.C. Sec. 103. That features, even distinguishing features, are 'disclosed' in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. 35 U.S.C. Sec. 103."

Accordingly, again, it is submitted, claims 12-19 are patentable over French and a

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finding to this effect is respectfully solicited.

The Examiner noted that prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Specifically, he referred to the following patents With accompanying comments:

"Ha et al. (US Patent Number 5,872,515) disclose laptop computer with an anti theft alarm function and a method of controlling the same.

Scholder (US Patent Number 5,578,991) disclose security system and method for a portable personal computer.

Isikoff (US Patent Number 5,748,084) disclose device security system.

Saji (US Patent Number 5,479,489)disclose cordless telephone set having a warning representing that a storage battery is not being charged."

While applicant concurs with the determination of the Examiner that each of these references is pertinent for the subject matter of the present invention, it is nonetheless submitted that these references, neither taken individually nor in combination with each other or with any of the prior art of record, will render unpatentable any of claims 12-19, as presently written, in the application and applicant concurs with the Examiner's determination in this regard.

In light of new claims 12-19 and the arguments presented, it is earnestly requested that the Examiner grant allowance to claims 12-19, all of the claims presently in the

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application, thereby enabling a patent to issue by an early date.

Respectfully submitted,

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1/14/00
Date

CERTIFICATE OF MAILING

I hereby certify that this correspondence, an amendment in response to the Office Action dated August 17, 1999, is being deposited with the United States Postal Service today as first class mail addressed to Assistant Commissioner for Patents, Box NON-FEE AMENDMENT, Washington, D.C. 20231.

1/14/00
Date

Clairine F. Moran
Name of Person Making Deposit